

### **REMARKS**

Claims 1-7, 9, 10, 12-20 and 22 are pending in this application and presently stand rejected. By this amendment, Applicants have amended claims 1, 10, and 14. Applicants respectfully request reconsideration of this application in view of these amendments and the reasons demonstrated below by which the present claims are distinct from the art asserted by the Examiner.

#### ***Priority***

First, the Examiner acknowledges the Applicants' claim for priority, however, points out that the Applicants have not complied with the requirement for provisional application 60/4440,728, because there are no inventors in common with that application. The undersigned is considering the facts based on which prior counsel made the request for priority and will modify the request for priority, if necessary.

#### ***Claim Objections***

In paragraph 4 of the office action, the Examiner objected to claims 1-8, 9, 10, 12-20, and 22 because of the informality that claims 1, 10, and 14 recite "indexed in response to the location," without making clear which location is referenced. Applicants respectfully submit that claim 8 is canceled, therefore, assume this rejection relates to only claims 1-7, 9, 10, 12-20, and 22. Claims 1, 10, and 14 are amended to clarify the location referenced. Accordingly, claims 2-7, 9, 12-13, and 15-20, which depend on claims 1, 10, and 14 also incorporate the clarification. The Examiner is respectfully requested to withdraw the objection of claims 1-8, 9, 10, 12-20, and 22.

#### ***Section 103 Rejections***

In paragraph 6 of the office action, claims 1 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,742,807 to Masinter ("Masinter") in view of U.S. Patent No. 6,947,954 to Cohen et al. ("Cohen et al."). Further, in paragraph 8 of the office action, the Examiner rejected claims 2-4, 6-7, 9-10, 12-13, 15-17, 19-22 under 35 U.S.C. 103(a) as unpatentable over Masinter in view of Cohen et al., as applied to claims 1 and 14, and further

in view of U.S. Patent No. 6,928,526 to Zhu et al. (“Zhu et al.”). In paragraph 9 of the office action, the Examiner rejected claims 5 and 18 under 35 U.S.C. 103(a) as unpatentable over Masinter in view of Zhu et al., in light of Applicants’ allegedly “admitted” prior art.

***Governing Criteria for a 35 U.S.C. § 103 Rejection***

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03.

The Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al.* (550 U.S. 127 S. Ct. 1727 (2007))) to be “expansive and flexible” and “functional.” However, even with this standard, it should be recognized that the various noted factors only “can” or “might” be indicative of obviousness based on the facts. The Supreme Court in *KSR* enunciated the following principles:

“[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill....[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). The Supreme Court while recognizing the need “to guard against slipping into the use of hindsight,” acknowledged the following principles:

[r]ejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims.

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *See* 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993). The Supreme Court in *KSR* stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.

An examiner may often find every element of a claimed invention in the prior art. "Virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983), cert. denied, 464 U.S. 1043 (1984); *See also Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The Supreme Court in *KSR* has also stated that:

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place.

Further, the Supreme Court states that:

The Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.

***Discussion of the Rejection under 35 U.S.C. § 103 Rejection***

With respect to the rejection of claims 1 and 14 under 35 U.S.C. 103(a) as unpatentable over Masinter in view of Cohen et al., the Examiner acknowledges that Masinter does not distinctly disclose that the attribute (metadata) is a location where the file was stored in the first environment. That void, the Examiner believes is filled by Cohen et al., at column 6, lines 50-64. Accordingly, the Examiner alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Masinter to include the teachings of Cohen et al., because these teachings would be common file attributes that are known to the system and the user at the time of storing, and would help the system and the user to uniquely identify the file. The Examiner further points out that using “just a document title” as suggested in Masinter would cause problems in cases where there are multiple files with the same name. Using other information such as “locations” would help solve this problem.

For a proper rejection based on a combination of Masinter and Cohen et al., a combination of the two references must teach all the claimed elements. Applicants respectfully submit that even if the combination of the two asserted references was obvious to one of ordinary skill in the art, the combination does not satisfy all the claimed elements. For example, Masinter teaches that an attribute's hash 22 is the index into a hash-to-location table 20, which then points to the location 24. Accordingly, Masinter's system uses the attribute's hash 22 to look up the location 24. But Masinter fails to teach an opposite technique (e.g., to look up the attribute in response to the location). Contrary to Masinter, claim 1 requires the step “in the second environment, storing the location in a location table, wherein the location table includes at least one of the following: a link to the content, indexed in response to the location; and a link to the

metadata, indexed in response to the location," which step is clearly not taught in Masinter. Moreover, Masinter fails to teach the step of "reconstituting at least a piece of the file by accessing at least one of the following in the location table: the link to the content, in response to the location; and the link to the metadata, in response to the location." Nor does Cohen et al., teach these steps at column 6, lines 50-64 (to which the Examiner points), where there is only a general description that the metadata may include any one or more of the following "file names (short or long), attributes, file times (e.g., create/access/modify), compression formats, locations (e.g. directories), directory structures, security information (e.g., access control list (ACL)) and/or stream names." Clearly, storing the "location" in a location table wherein the location table includes at least one of the following: a link to the content, indexed in response to the location; and a link to the metadata, indexed in response to the location," is not an essential element in Cohen et al. Moreover, the very fact that Masinter suggests "just a document title" and the Examiner indicates that this would cause problems in cases where there are multiple files with the same name is evidence of the fact that Masinter does not recognize nor address cases that involve multiple files with the same name. It is the Examiner, with the benefit of hindsight, who recognizes that using other information such as "locations" would help solve a problem in Masinter.

Further, claims 1 and 14 recite an additional step of "storing the content in a content hash table and the metadata in a metadata hash table," which is not taught by the combination of Masinter and Cohen et al. Applicants respectfully request the Examiner to withdraw the rejection of 1 and 14 under 35 U.S.C. 103(a).

With respect to the rejection of claims 2-4, 6-7, 9-10, 12-13, 15-17, 19-22 under 35 U.S.C. 103(a) as being unpatentable over Masinter in view of Cohen et al., as applied to claims 1 and 14, and in further view of Zhu et al. (U.S. patent No. 6,928,526), Applicants respectfully submit that claims 2-4, 6-7, and 9 ultimately depend on claim 1 and are therefore, distinct at least for the reasons by which claim 1 is distinct. Likewise, claims 15-17 and 19-20 ultimately depend on claim 14, and are distinct at least for the same reasons by which, claim 14 is distinct. Accordingly, Applicants address the rejection with respect to claims 10 and 12-13. Claim 10 also recites the limitations that distinguish claims 1 and 14 from Masinter and Cohen et al., therefore, a further combination with Zhu would still render the claims distinct, even if Zhu et

al., teaches features to reduce latency and eliminate unnecessary data replication (Zhu et al., column 1, lines 60-67). Claims 12-13 depend on claim 10 and are distinct at least for these reasons.

With respect to the rejection of claims 5 and 18 over Masinter in view of Zhu et al., in light of Applicant's allegedly admitted prior art, Applicants respectfully submit that claim 5 ultimately depends on claim 1 and claim 18 ultimately depends on claim 14, and both these claims are distinct at least by the reasons that distinguish claims 1 and 14 from the primary references.

### **CONCLUSION**

In view of the above amendments and remarks, Applicants respectfully request reconsideration of the rejected claims and solicit their allowance. Applicants propose an interview (by telephone or in person) to resolve any outstanding issues. Favorable consideration of the claims presented here is respectfully requested.

Respectfully submitted,

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